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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,434	09/30/2003	Eizi Yokoyama	040894-5652-01	2611
9629 7590 02/12/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
PHAN, THIEM D				
ART UNIT		PAPER NUMBER		
3729				
MAIL DATE		DELIVERY MODE		
02/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,434

Applicant(s)

YOKOYAMA ET AL.

Examiner

THIEM PHAN

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 4 and 7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/819,694.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 11/02/06 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being anticipated by Shoji et al (US 5,982,629).

With regard to claim 4, Shojiet et al teach a method of fabricating a circuit board (Col. 3, lines 29+), comprising the steps of:

- a step of forming a terminal portion (Fig. 1, 2) in manufacturing a square-shaped circuit board (Fig. 1, 1; col. 7, line 40), said step of forming a terminal portion being to stack a base layer of copper or Cu (Fig. 1, 2; col. 4, lines 45-48) and a plated layer of gold or Au (Fig. 1, 3; col. 2, lines 45 & 46) successively to form the terminal portion; except for having the circuit board made of glass epoxy resin; and

- a step of forming an insulating layer (Fig. 9, 5) after said step of forming a terminal portion in manufacturing said circuit board, said step of forming an insulating layer being to form an insulating layer in the other area than the area where said terminal portion (Fig. 9, 2) is formed,
- wherein said insulating layer is formed so as to cover a peripheral edge of said plated layer (Fig. 9, 3; col. 5, lines 28-30) so that the surface of said circuit board and at least one of the surface of the base layer (Fig. 9, 2) are not exposed externally, and the insulating layer (Fig. 9, 5; col. 11, lines 38 & 39) is made of epoxy resin.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the circuit board made of glass epoxy resin because applicants have not disclose that having the circuit board made of glass epoxy resin provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicants' invention to perform equally well with a silicon substrate material because it insulates and supports the conductive regions (Fig. 1, 2 & 3) as well.

Therefore, it would have been an obvious matter of design choice to modify Shojiet et al to obtain the invention as specified in Claim 4.

With regard to claim 7, Shojiet al teach the further steps of:

- forming a base layer of a copper pattern (Fig. 1, 2) on a surface of an insulating board (Fig. 1, 1);

- forming a plated layer (Fig. 1, 3) so as to cover the entire base layer (Fig. 1, 2) by selective plating (Col. 5, line 5); and
- forming an insulating layer (Fig. 9, 5) on said plated layer (Fig. 9, 3) and patterning said insulating layer so that only a portion of said plated layer is exposed externally.

Response to Arguments

4. Applicants' arguments with respect to claims 4 and 7 have been considered but are moot in view of the new grounds of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M & Tu, 6AM - 2PM, and W & Th, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tim Phan/

Examiner, Art Unit 3729

Tim Phan
Examiner
Art Unit 3729

tp
February 8, 2008